

## **REMARKS**

### **I. Introduction**

With the cancellation of claim 2, without prejudice, claims 1 and 3-13 are currently pending. Applicant gratefully acknowledges the Examiner's indication that claims 5-7 and 11-13 contain allowable subject matter. Claims 5, 6, 11 and 12 have accordingly been rewritten in independent form.

In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the currently pending claims are allowable, and reconsideration is respectfully requested.

### **II. Rejection of Claims 1-4 and 8-10 Under 35 U.S.C. § 103(a)**

Claims 1-4 and 8-10 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Guilbert et al. (U.S. Patent No. 6,075,072) ("Guilbert").

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Independent claim 1, as amended, recites the feature of at least one lacquer layer including microcapsules, a first portion of the microcapsules filled with a corrosion inhibitor, a second portion of the microcapsules filled with a hardenable substance that includes an isocyanate.

Even assuming *arguendo* the equivalence of the film-forming components referred to in Guilbert with the hardenable substance claimed (which is not admitted),

Guilbert does not disclose or suggest a film-forming component enclosed within a microcapsule that includes an isocyanate compound. See Guilbert, col. 5, lines 12-20 (providing a listing of film-forming components used in the capsules according to Guilbert). It is therefore submitted that Guilbert does not disclose or suggest all of the features of claim 1, or of its dependent claims 3 and 4.

As independent claim 8 has been amended in like manner to claim 1, it is submitted that Guilbert likewise fails to disclose or suggest each of the features of claim 8, and its dependent claims 9 and 10.

For at least the foregoing reason, it is submitted that the pending claims are patentable over Guilbert, and withdrawal of the obviousness rejection of these claims is respectfully requested.

### III. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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